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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,709	02/26/2002	Akira Ogino	SONYJP-183	5278

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Westfield, NJ 07090

EXAMINER
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VENT, JAMIE J

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/069,709	Applicant(s) OGINO, AKIRA	
	Examiner Jamie Vent	Art Unit 2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-8, 10, and 12-17 are rejected under 35 U.S.C. 102(b) as being unpatentable by Ellis et al (US 6,470,497).

#### **[claims 1 & 10]**

In regard to Claims 1 and 10, Ellis et al, discloses an additional information inserting apparatus and method for superimposing additional information on main information signals, comprising:

- Generating first and second insertion signals from the additional information (Figure 5a shows the first and second insertion signals in the form of a graphic overlay wherein additional information regarding the received program signal is displayed); and
- Superimposing the first and second insertion signal on the main information signals such that the first insertion signals are superimposed on first intervals of the main information signals and the second insertion signals are superimposed on second intervals of the main information signals, the first intervals and the second intervals existing alternately along a time direction of the main information signals (Column 10 Lines 20-52 describes the superimposing of the insertion signals/graphic overlay onto the main received program

information signal and the intervals in which the first and second insertion signals are superimposed onto the main information signal).

**[claims 3 & 12]**

In regard to Claims 3 and 12, Ellis et al, discloses the additional information inserting apparatus and method wherein superimposing means superimposes the first and second insertion signals on the main information signals at predetermined intervals (Column 9 Lines 45-65 describes the intervals wherein the first and second insertion signals are superimposed onto the main information signal).

**[claims 4 & 13]**

In regard to Claims 4 and 13, Ellis et al, discloses the additional information inserting apparatus and method wherein the superimposing means superimposes the first and second insertion signals on the main information signals at intervals of a predetermined number of frames or fields (Column 9 Lines 45-65 describes the intervals of time wherein the first and second insertion signals are superimposed onto the main signal. By superimposing the signal at a predetermined time would allow the insertion to occur during a predetermined number of frames associated with the predetermined set time).

**[claims 5 & 14]**

In regard to Claims 5 and 14, Ellis et al discloses the inserting apparatus and method wherein the superimposing means superimposes the first insertion signals and the second insertion signals to a plurality of regions of the main information signals, which regions are obtained by dividing signal units constituting the main information signals (Figures 5a-5c shows regions wherein first and second insertion signals are inserted onto the main information signal. Furthermore, it is described in Column 9 Lines 7-15 the regions of superimposing the insertion signal onto the main information signal).

**[claims 6 & 15]**

In regard to Claims 6 and 15, Ellis et al discloses the additional information inserting apparatus and method wherein the main information signals are image signals having frames or fields, and signal units

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of the main information signals are the frames or fields of the image signals (Figure 12b shows that the main information signals have frames or fields of an image signal as further disclosed in Column 9 Lines 10-21 wherein the main information signal is described as a NTSC format program signal and thereby meeting the limitation of image signal).

**[claims 7 & 16]**

In regard to Claims 7 and 16, Ellis et al discloses an inserting apparatus and method wherein the insertion signal generating means generates the first insertion signals and the second insertion signals from identical additional information (Column 9 Lines 23-33 describes the insertions signals are obtained by the programming information that is supplied from the RGB generator by the micro controller and thereby making the signal source identical).

**[claims 8 & 17]**

In regard to Claims 8 and 17, Ellis et al discloses an inserting apparatus and method wherein inserting signal generating means generates the first insertion signals and the second insertion signals by the use of key information, and generates different insertion signals by the use of key information, and generates different insertion signals from the additional information by varying the key information to be used (Column 10 Lines 16-52 describes the "FLIP" between various insertion signals by the use of information obtained from the user thereby varying key information to be used).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al (US 6,470,497) in view of Sugita et al (US 6,381,402).

**[claims 9 & 18]**

In regard to Claims 9 and 18, Ellis et al discloses inserting apparatus and method wherein the insertion signal generating means generates different insertion signals from the additional information, as disclosed in Column 9 Lines 5+, however, fails to disclose the generation of additional information through varying the encoding method. Sugita et al discloses an information output device and as seen in Figure 8 element 22 shows the coding unit, which uses varying encoding methods as further described in Column 11 Lines 7-12. The use of varying encoding methods allows for the signal to be more difficult to copy thus allowing a more credible method of copy control. Therefore, it would have been obvious to one of ordinary skill in the art to use the inserting apparatus, as disclosed by Ellis et al, and incorporate an encoding technique for the additional information, as disclosed by Sugita et al, to allow for copy protection of the information signal.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 703-305-0378. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamie Vent  
01/10/05



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